

United States ²
Circuit Court of Appeals

In and for the Ninth Circuit

THE PACIFIC MARINE SUPPLY
COMPANY and WEBB PROD-
UCTS CO., INC.,

Appellants,

vs.

THE A. S. BOYLE COMPANY,

Appellee.

Opening Brief for Appellants

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8876

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STATEMENT OF JURISDICTIONAL FACTS

In this suit plaintiff, The A. S. Boyle Company, alleged infringement of United States Letters Patent to Griffiths No. 1,838,618, by the defendant, The Pacific Marine Supply Company, for having sold Duratite Wood Dough and Duratite Seam Putty (R. 4, paragraph 5).

The District Court thus had jurisdiction under Judicial Code, Sec. 48; 28 U. S. C. 109.

The defendant, The Pacific Marine Supply Company, was a distributor retailing a comparatively small amount of the alleged infringing products. The alleged infringing products were manufactured by the

Intervener, Webb Products Co., Inc., at San Bernardino, California. Consequently, Webb Products Co., Inc., intervened as a manufacturer in the suit brought against its distributor the defendant, The Pacific Marine Supply Company (R. 18-26).

Of claims 5, 6, 8, 11, 13, 16, 17, and 18 alleged to be infringed (R. 4, paragraph 5) the District Court held that claims 5, 8, 13, 16, and 17 were valid and infringed by Duratite Wood Dough (R. 63, 86). The remaining claims were held not to be infringed (R. 61).

The product called Duratite Seam Putty was withdrawn from issue by the plaintiff's attorney in his opening statement (R. 107).

An Interlocutory Decree was entered holding claims 5, 8, 13, 16, and 17 infringed by Duratite Wood Dough.

This appeal is prosecuted from such holding under Judicial Code Section 129; 28 U. S. C. A. 227A. No cross-appeal from the holding that claims 6, 11, 15, and 18 are not infringed has been filed by the plaintiff-appellee.

STATEMENT OF THE CASE

The Griffiths patent in suit (Ex. Bk., p. 1) is for a plastic composition used for "filling, coating or molding" (Ex. Bk., p. 1, ll. 4 and 5).

Its essential ingredients are:

- (1) Nitrocellulose which serves as a binder;
- (2) A volatile solvent therefor, such as acetone;

(3) Finely divided cellulose filler such as wood flour (see R. 105, 114-115).

The plaintiff asserts two additional ingredients, namely

(4) Oil, which ameliorates the brittleness of the nitrocellulose binder when the volatile solvent evaporates away; and

(5) Gum, which contributes adhesiveness to the composition

are non-essential or less essential (R. 106) although the patent itself makes no disclosure that these ingredients can be omitted.

As set forth in the patent in suit, the ratio of filler (finely divided cellulose or wood flour) to a solution of nitrocellulose, solvent, gum, and oil is from 15 to 30 parts filler to 85 to 70 parts solution (Ex. Bk., p. 1, ll. 58-60). Proportions outside of these limits may be employed (Ex. Bk., p. 1, ll. 60 to 63).

A typical claim of the patent reads:

“5. A doughy putty-like plastic composition comprising nitrocellulose in a solution containing a volatile liquid, and a finely divided cellulose filler in such proportions as to harden upon mere exposure to air to substantially the rigidity and solidity of wood.”

The analysis of the alleged infringing Duratite Wood Dough is (R. 116) nitrocellulose, 10.5% by weight; solvent, 41% by weight; filler 11.5% by weight; gums and oils 5.7% by weight; inorganic material, 31.3% by weight.

Of course, if claim 5 is to be construed as valid and as being broad enough to cover all plastic compositions containing nitrocellulose, volatile solvent, and finely divided cellulose filler—regardless of the percentages of the ingredients—then this claim is readable on the Duratite Wood Dough composition. The Duratite Wood Dough does contain nitrocellulose, volatile solvent, and finely divided cellulose filler. But the proportions are vastly different from what is disclosed in the Griffiths patent. Instead of having the filler content between 15 and 30% by weight as stated in lines 58 to 60 of the Griffiths patent (Ex. Bk., p. 1) and in claims 6, 11, 15, and 18 thereof, and instead of having filler content between 20 and 25% as stated by the Griffiths patent (Ex. Bk., p. 1, l. 67) the Duratite Wood Dough has a filler content of only 11.5%.

But all proportions of nitrocellulose, volatile solvent, and finely divided cellulose filler will not produce the desired result (R. 332). The plaintiff and the Lower Court therefore have been forced to rely on the nebulous functional and indefinite statements in the claims that the composition is “doughy, putty-like” and that the ingredients are

“in such proportions as to harden upon mere exposure to air to substantially the rigidity and solidity of wood” (R. 64).

These claims in such nebulous functional and indefinite form were never granted by the officials of the Patent Office. The record of the Griffiths application shows that the Examiner denied these claims. An ap-

peal was taken to the Board of Appeals. That tribunal also denied these claims. In so doing it criticized the vague, indefinite, and functional character of these claims (Ex. Bk., pp. 59, 60). Instead of appealing to the Court of Customs and Patent Appeals, suit was brought under the provisions of R.S. 4915 in the Supreme Court of the District of Columbia. The unenlightened judge therein reversed the Patent Office and awarded all claims appealed, which included those now in issue herein, regardless of their manifestly functional character.

But the strange part of all these proceedings is that the best or closest prior art was not developed nor cited by the Examiner nor by the Board of Appeals nor was it placed in evidence before the Judge of the Supreme Court of the District of Columbia who reversed the Patent Office. The Patent Office found no patentability to exist in the claims now in issue on art that was inferior to the prior art now before this Court. When the Supreme Court of the District of Columbia reversed the Patent Office it did not have the Pierson or Oblasser patents before it. (Interrogatories 25 and 26, R. 190 and 191.)

The Lower Court herein has been unduly impressed by the decision of the Supreme Court of the District of Columbia (R. 63). But it should not have been so influenced when, as appears from the record herein (R. 190, 191) that Court did not have the best prior art before it, namely the Pierson and Oblasser patents.

The Lower Court herein has also been unduly impressed by the decision of the District Court of Massachusetts (R. 63) which sustained the patent in suit. Such holding, however, can have little influence in this Court.

Icyclair, Inc., vs. National Popsicle Corp., et al.,
94 Fed. (2nd) 669;

Triplett vs. Lowell, 297 U. S. 638.

Likewise, the Lower Court herein has been unduly impressed by the plaintiff's commercial success (R. 63), but commercial success is not a substitute for invention, particularly when it is largely based upon the plaintiff's ability to spend enormous amounts in advertising and on the plaintiff's catchy trade-name "Plastic Wood."

This appeal is based on the following:

(1) That the claims of the Griffiths patent held by the District Judge to be valid and infringed are invalid

(a) because they are too functional and indefinite to be valid, R. S. 4888;

(b) because they are anticipated by prior art, namely the Pierson and Oblasser patents, which were never before the Patent Office, nor before the Supreme Court of the District of Columbia;

(c) because the composition defined by the claims lacks invention over the prior art.

(2) If the claims are narrowed by the Pierson patent as stated by the District Judge (R. 64) then they cannot be construed to cover Duratite Wood

Dough which has a radically different composition.

ASSIGNMENTS OF ERROR RELIED UPON

Assignments of error directed to the vagueness, functionality, and indefiniteness of the claims are 20, 21, 22, and 23 (R. 96, 97).

Assignments of error directed to anticipation of claims by the Pierson and Oblasser patents are 7, 8, 10, 11, 17, and 18 (R. 92-96).

Assignments of error directed to the claims lacking invention over the prior art are 9, 12, 13, 14, 15, 16, and 19 (R. 93-96).

The assignment of error directed to the holding of infringement is 34 (R. 99).

**CLAIMS 5, 8, 13, 16, AND 17 ARE TOO BROAD,
VAGUE, FUNCTIONAL, AND INDEFINITE
TO BE VALID.**

20.

The Court erred in failing to hold that claims 5, 8, 13, 16, and 17 of Griffiths patent No. 1,838,618 are invalid as being vague and indefinite.

21.

The Court erred in failing to hold claims 5, 8, 13, 16, and 17 of Griffiths patent No. 1,838,618 are invalid as being broader than the invention.

22.

The Court erred in failing to hold claims 5, 8, 13, 16, and 17 of Griffiths patent No. 1,838,618 are invalid for the reason that there is no foundation in the specification or any definition therein as to what constitutes a doughy, putty-like plastic composition.

23.

The Court erred in failing to hold that claims 5, 8, 13, 16, and 17 of the Griffiths patent No. 1,838,618 were invalid as being vague and indefinite as to when a composition hardens into substantially the rigidity and solidity of wood and in failing to find that the defendant's and intervener's compositions did not harden into substantially the rigidity and solidity of gypsum.

Each of the claims held valid and infringed recite "A doughy, putty-like plastic composition" comprising nitrocellulose, a volatile solvent, a finely divided cellulose filler with or without gum or oil

"in such proportions as to harden upon mere exposure to air to substantially the rigidity and solidity of wood,"

or words to that effect.

There are no limitations or definitions in these claims as to what these proportions are. The specification of the patent makes no definition of what is meant by “doughy, putty-like” or within what limits the proportions must be to enable the composition

“to harden upon mere exposure to air to substantially the rigidity and solidity of wood.”

If these proportions must lie between 20 and 25 parts of filler as stated in the patent, line 67, or between 15 and 30 parts as stated in lines 58 and 59, then there obviously is no infringement because the defendant’s composition contains only 11.5% of filler.

In the prior art there are the Pierson and Oblasser patents (Ex. A7 and A10, Ex. Bk., pp. 71, 81). These contain the same three essential ingredients, namely nitrocellulose, volatile solvent, and finely divided cellulose filler, as admitted by the plaintiff-appellee’s own expert Esselen (R. 330):

“Q. Well, you do find in the Pierson patent, don’t you, a composition composed of nitro-cellulose in a solution containing a volatile liquid and a finely-divided cellulose filler?”

“A. Yes . . . ”

(R. 332):

“Q. It (the Oblasser patent) indicates plastic, and he has presented there a nitro-cellulose in a solution containing a volatile liquid and a finely-divided cellulose filler, hasn’t he?”

“A. That is true . . . ”

Both Pierson's and Oblasser's compositions are for "molding." Pierson says his is for molding and statuary (Ex. Bk., p. 72, middle of column 1) and Oblasser discloses molding a battery box from his composition.

The claims of the Griffiths patent thus differentiate from the Pierson and Oblasser patents, if at all, merely by the functional statement that the ingredients shall be

"in such proportion as to harden upon mere exposure to air to substantially the rigidity and solidity of wood."

How is a manufacturer seeking to follow what is taught or disclosed by the Pierson and Oblasser patents, which are now public property in this country, going to be able to ascertain when he is or is not infringing the indefinite claims of Griffiths? If he makes a moldable composition following the disclosure of Pierson or Oblasser he will have a composition that produces on drying in air a solid substance having

"substantially the rigidity and solidity of wood"

(see Ex. A-34, A-36, A-38, A-42, A-43, A-45), made up in accordance with the disclosures of these patents.

The attempted differentiation of the Griffiths patent from Pierson and Oblasser of the prior art by the functional statement

"in such proportions as to harden upon mere exposure to air to substantially the rigidity and solidity of wood"

compares favorably with the functional statement before the Supreme Court in *General Electric Co. v. Washburn Appliance Corp., et al.*, 37 U. S. P. Q. 466;U. S. decided May 16, 1938.

“The claim further states that the grains must be ‘of such size and contour as to prevent substantial sagging and offsetting’ during a commercially useful life for the lamp. The clause is inadequate as a description of the structural characteristics of the grains. Apart from the statement with respect to their function, nothing said about their size distinguishes the earliest filaments, and nothing whatever is said which is descriptive of their contour (termed by the district court a ‘very important element’), not even that they are irregular.

“The claim uses indeterminate adjectives which describe the function of the grains to the exclusion of any structural definition and thus falls within the condemnation of the doctrine that a patentee may not broaden his product claims by describing the product in terms of function. Claim 25 vividly illustrates the vice of a description in terms of function. ‘As a description of the invention it is insufficient and if allowed would extend the monopoly beyond the invention.’ The Court of Appeals for the Ninth Circuit relied on the fact that the description in the claims is not ‘wholly’ functional. 80 F. (2d) 958, 963. But the vice of a functional claim exists not only when a claim ‘wholly’ functional, if that is ever true, but also when the inventor is painstaking *when he recites what has already been seen and then uses conveni-*

ently functional language at the exact point of novelty.

“A limited use of terms of effect or result which *accurately* define the essential qualities of a product to one skilled in the art, may in some instances be permissible and even desirable, *but a characteristic essential to novelty may not be distinguished from the old art solely by its tendency to remedy the problems in the art met by the patent.*”

Here, as the prior art Pierson and Oblasser disclose moldable compositions made up of nitrocellulose, volatile solvent, and finely divided cellulose filler—and this fact is admitted by the plaintiff’s own expert Esselen—a conveniently functional statement is resorted to “at the exact point of novelty,” if any novelty existed, to differentiate from the prior art. The vice of these claims is that no one can tell when he departs from making the Pierson and Oblasser compositions and falls within the domain of Griffiths and is making a composition which has “such proportions” as to harden upon drying “to substantially the rigidity and solidity of wood.”

In this case the Intervener used only 11.5% by weight of wood flour and inorganic materials to the extent of 31.3% by weight (R. 116). The inorganic materials were identified by the plaintiff’s expert Esselen as gypsum (R. 116). If, as contended by plaintiff the intervener’s composition contained 31.3% of gypsum, then the intervener’s product would be properly

characterized as hardening upon mere exposure to air “to substantially the rigidity and solidity of” gypsum.

We ask this Court to invalidate these claims in the same manner that the Supreme Court did in the above case in the following language:

“We need not inquire whether Pacz’s exhibited invention, or whether his product was anticipated. The claim is invalid on its face. It fails to make a disclosure sufficiently definite to satisfy the requirements of R. S. 4888; 35 U. S. C. 33.”

However, as this Court may be interested in how closely the prior art anticipated the invention the following is submitted:

**CLAIMS 5, 8 AND 17 ARE ANTICIPATED BY
THE PIERSON AND OBLASSER PATENTS
EXHIBITS A7 AND A10.**

7.

The Court erred in failing to hold that claim 5 of Griffiths patent No. 1,838,618 is invalid in view of the disclosure in United States Letters Patent to Pierson No. 65,267, issued May 28, 1867.

8.

The Court erred in failing to hold claim 5 of Griffiths patent No. 1,838,618 invalid in view of the disclosure of the British patent to Oblasser et al. No. 19,242 of 1892.

10.

The Court erred in failing to hold that claim 8 of Griffiths patent No. 1,838,618 is invalid in view of the disclosure in United States Letters Patent to Pierson No. 65,267 issued May 28, 1867.

11.

The Court erred in failing to hold claim 8 of Griffiths patent No. 1,838,618 invalid in view of the disclosure of the British patent to Oblasser et al. No. 19242, of 1892.

17.

The Court erred in failing to hold that claim 17 of Griffiths patent No. 1,838,618 is invalid in view of the disclosure in United States Letters Patent to Pierson No. 65,267, issued May 28, 1867.

18.

The Court erred in failing to hold claim 17 of Griffiths patent No. 1,838,618 invalid in view of the disclosure of the British patent to Oblasser et al. No. 19,242 of 1892.

Considering first claim 5 of the Griffiths patent, this claim merely calls for a doughy composition of nitro-cellulose, volatile solvent, and finely divided cellulose filler in such proportions as to harden into substantially the rigidity and solidity of wood.

The Pierson patent makes such a disclosure. Pierson first discloses nitrating various forms of cellulose (Ex. Bk., p. 71, column 1). He denominates his nitro cellulose as "plastic." At the top of column 1 (Ex. Bk., opposite p. 72) he says:

"In practice, I propose to produce the fabrics above named by mixing the plastic and solvents with mineral or vegetable powders . . . "

Thus, when he mixes his "plastic" with solvents and vegetable powders he has a composition of nitrocellulose, solvent, and finely divided cellulose as claimed by Griffiths. Furthermore, the composition is stated to be for molding the various articles mentioned at the bottom of column 2 (Ex. Bk., p. 71). Griffiths likewise says that his composition is for molding (Ex. Bk., p. 1, l. 5). If the disclosure in Griffiths to the effect that his composition is for "molding" justifies his claiming in his claims that the composition is "doughy, putty-like," then obviously the statement in Pierson that his composition is for molding justifies the same appellation.

Pierson further gives a concrete example of his moldable composition. He says, at the middle of the first column (Ex. Bk., p. 72):

"In carbons, &c., take plastic, one part; alcohol, four; ether, four; charcoal powder, one to sixteen. Lamp-black or plumbago may be substituted for the charcoal, *sawdust, straw, or any vegetable powder or fiber* may also be substituted for the charcoal, and oil may often be added to advantage, useful for statuary and moldings, and

some forms for paints, and some for marking-pencils, and for other purposes.”

If one part of sawdust or vegetable powder filler is used, the percentage is

$$\frac{1 \text{ part filler}}{1 \text{ part plastic} + 4 \text{ parts alcohol} + 4 \text{ parts ether} + 1 \text{ part filler}} = \frac{1}{10} = 10\%.$$

If sixteen parts are used, the percentage of filler is

$$\frac{16 \text{ parts filler}}{1 \text{ part plastic} + 4 \text{ parts alcohol} + 4 \text{ parts ether} + 16 \text{ parts filler}} = \frac{16}{25} = 64\%$$

Thus, Pierson here discloses a composition of nitro-cellulose (plastic), volatile solvent (alcohol and ether), and finely divided cellulose (sawdust or vegetable powder)—the proportions of filler to the whole being 10 to 64%. The Griffiths composition contains from 15 to 30% filler which is in the center of Pierson’s larger range. Griffiths says (Ex. Bk. p. 1, line 60):

“On the other hand, proportions outside these limits may be employed.”

Obviously, if Griffiths’ composition having 15 to 30% filler, or even filler in a percentage outside these limits, is “doughy” or “putty-like” as described by the Griffiths claims, Pierson having his filler present from 10% to 64% has the same characteristics. If Griffiths has such characteristic as to “harden upon mere exposure to air to substantially the rigidity and solidity of

wood," Pierson's composition likewise possesses these properties. This is because the compositions are the same, having the same ingredients in the same relative proportions. Pierson merely gives a wider range of filler because of the number of different substances suggested for use as fillers.

The experts are in agreement as to what Pierson discloses. Defendant's expert Roller said (R. 206):

"Q. Now, referring to claim 5 of the Griffiths patent, do you have in the Pierson patent a description in that lower paragraph of Column 1, page 3, 'A doughy, putty-like plastic composition comprising nitro-cellulose in solution, containing a volatile liquid and a finely-divided cellulose filler?'

"A. Yes, you do if you used your sawdust or straw or vegetable powder which Pierson specified.

"Q. Now, is that composition of such proportions that it will harden upon mere exposure to air to substantially the rigidity and solidity of wood?

"A. Yes."

Obviously, this is true. If less filler is present, more time is required to evaporate the solvent. If more filler is present, there is less proportional solvent and consequently less time is required to evaporate it. But the result is the same. The composition hardens to substantially the rigidity and solidity of wood. Regardless of whether there is more or less solvent present, all of it must be evaporated or dried off.

Even the plaintiff recognizes this. It markets its Plastic Wood in cans and in collapsible tubes. That

which is placed in tubes is of much thinner consistency containing more solvent than that which is placed in cans (R. 304, 315). Also the plaintiff markets solvent in cans for use with its Plastic Wood when its Plastic Wood has become too stiff or dry (R. 303). In using it to restore Plastic Wood to its original consistency the directions say merely "pour in a little Plastic Wood Solvent." How much solvent is to be poured in is not stated. It is not very material. The user is to use his own judgment. A little more or less solvent does not materially affect the product—merely the length of time for the solvent to completely evaporate.

Plaintiff's expert Esselen agrees with Roller as to the disclosure of the Pierson patent (R. 330):

"Q. Well, you do find in the Pierson patent, don't you, a composition composed of nitro-cellulose in a solution containing a volatile liquid and a finely-divided cellulose filler?"

"A. Yes, without any proportions or other suggestions given."

The answer is in error with respect to the lack of proportions in Pierson. Pierson does set forth, as quoted above, the proportions as being one part plastic (nitro-cellulose); 4 parts alcohol; 4 parts ether, and one to sixteen parts filler, depending upon the filler used.

But even if the statement was true as to the lack of proportions there would be nothing patentable in selecting any particular proportions. There is nothing critical about the proportions used in the composition (R. 272, 273). As Pierson states that his composition is for mold-

ing—the same purpose as Griffiths—the obvious thing to do would be to make up a solution of one part nitrocellulose; 4 parts alcohol; 4 parts ether, and add to this solution enough sawdust or vegetable powder filler until the desired consistency for molding was obtained.

A child indulging in the disapproved but fascinating pastime of making mud pies follows the same procedure—namely, adding dirt to water until the desired consistency for mud pie making is obtained.

The Oblasser patent (Ex. Bk., p. 81) makes a similar disclosure wherein the reader is expected to use some judgment in securing whatever consistency he desires. He first describes nitrating cellulose and then adding camphor which would convert the nitrocellulose to celluloid (Ex. Bk., p. 82, ll. 37-40; R. 230). He then dissolves in a solvent such as acetone (Ex. Bk., p. 82, l. 42) producing a coating (l. 43). Finally,

“By mixing our coating with certain substances we may obtain a sort of agglomerate susceptible of being moulded.” (Ex. Bk., p. 82, ll. 50, 51.)

Among the materials suggested for mixing with the coating are “sawdust or cork waste, cork powder,” (l. 53).

“Under these circumstances, instead of rendering a receptacle of wood or other material tight by the application of our coating *we may manufacture it directly by moulding, use being made of the said agglomerate.*” (Ex. Bk., p. 83, ll. 1-3.)

There is thus a disclosure in Oblasser of a moldable composition made up of nitrocellulose, a volatile sol-

vent, and finely divided cellulose filler. It is to harden upon mere drying in air into a substitute for wood in the manufacture of battery boxes.

There is no novelty whatever defined in Griffiths' claim 5 over what is disclosed in the Pierson and Oblasser patents. Both patents disclose moldable compositions which would naturally be made of a doughy or putty-like consistency so as to be moldable. Both patents disclose the use of the three essential ingredients, to wit, nitrocellulose, a volatile solvent, and a finely divided cellulose filler. In both patents, the substance when hardened, will have substantially the rigidity and solidity of wood if sawdust or vegetable powders as suggested therein are used. Obviously, if some of the other fillers are used, such as metallic powders, suggested in both patents, the resulting product will take on the characteristics of the metallic powders.

Claim 8 of Griffiths patent specifies the presence of a "non-drying oil"—this being the only distinction from claim 5. Pierson says, at the middle of column 1 (Ex. Bk., p. 72):

"and oil may often be added to advantage."

The plaintiff's own expert Esselen said (R. 144, 145):

"Q. Now, if you have a compound containing nitro-cellulose, alcohol and ether and finely-divided sawdust or finely-divided vegetable powder you will necessarily have present in that composition some vegetable oil and some resin, isn't that correct?"

“A. What was the filler you included, Mr. Miller?”

“Q. Finely-divided sawdust or vegetable powder.”

“A. If you use dry vegetable powder you do not necessarily. Sawdust, of course, usually contains natural oil and the gum.”

Furthermore, castor oil was well known long prior to Griffiths alleged invention as a means for ameliorating the brittleness of nitro-cellulose compositions. This is the only function that castor oil performs in the Griffiths composition. Plaintiff's own expert Esselen testified (R. 144):

“Q. In fact, during 1915, 1916 and 1917 castor oil was a well-known ingredient to use in nitro-cellulose plastic compositions to ameliorate the brittleness of the composition, wasn't it?”

“A. Yes.”

He is in agreement with defendant's expert Roller (R. 208). See also the Parks patent (Ex. Bk., p. 142B, l. 37) where the use of castor oil is suggested for this purpose in a similar composition.

Therefore, the inclusion of the “non-drying oil” ingredient in claim 8 does not render this claim patentable over claim 5 which, as above pointed out, is anticipated by the Pierson and Oblasser patents.

Claim 13 differs from claim 5 in the following respects:

- (a) It specifies the presence of castor oil;
- (b) It specifies that the solvent is acetone;

(c) It specifies the presence of a resinous body, to wit, ester gum.

There is nothing patentable about specifying these ingredients. The addition of castor oil to reduce the brittleness of a nitro-cellulose composition was old and well known. Pierson even suggested that oil may often be added to advantage. (Middle of column 1, Ex. Bk., p. 72.) This specification in the claim did not impart patentability to it. Likewise, the use of acetone as a solvent for nitrocellulose was old and well known. It is specifically mentioned in the Oblasser patent as being the solvent. While Pierson suggested the use of alcohol and ether, it was long known prior to Griffiths alleged invention that acetone was a good substitute for alcohol and ether for this purpose (R. 144, 217). The recitation that there is present a resinous body or ester gum which imparts adhesiveness to the composition does not render the claim patentable. As stated by Esselen (R. 144, 145) sawdust would naturally contain some resin. Oblasser mentions the presence and use of resin. (Ex. Bk., p. 82, l. 54.) Furthermore, it was well known that nitro-cellulose compositions could have their adhesiveness increased by the addition of ester gum (R. 144).

There is nothing patentable about specifying these three ingredients in the claim any more so than in specifying the presence of a pigment to impart color to the composition or perfume to impart a delightful odor thereto.

Claim 16 is the same as claim 13 with the single exception that the volatile solvent is not definitely re-

cited as being acetone. It is anticipated by the Pierson and Oblasser patents for the same reasons. Acetone has long been recognized as a substitute for alcohol and ether as a solvent for nitrocellulose.

Claim 17 is of the same scope as claim 5, being merely of different phraseology. It is anticipated by the Pierson and Oblasser patents for the same reasons above advanced in connection with claim 5.

We are cognizant of the rule that a prior "paper" patent is to be narrowly construed as an anticipation. The Pierson patent, however, was not a "paper" patent. In fact, suit was brought upon the Pierson patent in *Celluloid Mfg. Co. vs. Crofut, et al.*, 24 F. 796, alleging that claims 1 and 2 had been infringed. Claim 2 of the Pierson patent covers the combination of "plastic," nitrocellulose in solution, with vegetable or any other foreign matter. It is thus manifest that compositions of the character now alleged to be infringed were manufactured by at least one infringer during the life of the Pierson patent. When the Pierson patent expired, all that was disclosed therein became public property. The public was entitled to make compositions of nitrocellulose, alcohol and ether, or equivalent solvents that were well known, and sawdust, or other vegetable powders. The public was entitled to make any composition between the one and sixteen parts or 10 and 64% of finely divided cellulose filler. It was manifestly improper for the District Court to hold that Griffiths at this late date could monopolize a composition in the center of the range disclosed by Pierson be-

cause Pierson's entire range became public property on the expiration of his patent.

**THERE IS NO INVENTION DEFINED BY THE
GRIFFITHS CLAIMS OVER THE STATE OF
THE ART.**

9.

The court erred in failing to hold claim 5 of Griffiths patent No. 1,838,618 invalid in view of the state of the art as evidenced by the following:

United States Patents

Merrick	1,203,229
Black	1,294,355
Eckstein	458,157
Deitz and Wayne	133,969
Ellis	999,490
Grawl	1,652,353
Arnold	1,195,431
Lindsay	1,493,207
Hyatt and Blake	89,582
Reagles	311,203
Jarvis	329,313
Dunwoody and Wills	1,187,890
Ritschke	1,497,028

and the British patents to:

Mennens	2,775	Nov. 13, 1860
Bulling	169,177	Dec. 18, 1922
De Pont et al	24,790	Nov. 5, 1896
Thompson	27,534	Nov. 23, 1897
Parks	2,675	Oct. 28, 1925
“	1,614	May 16, 1868

12.

The court erred in failing to hold claim 8 of Griffiths patent No. 1,838,618 invalid in view of the state of the art, particularly those patents as listed in the foregoing assignment numbered 9.

13.

The court erred in failing to hold claim 13 invalid for lack of invention over the disclosures in the United States Letters Patent to Pierson No. 65,267 and the British patent to Oblasser et al. No. 19,242 of 1892, particularly in view of the fact that acetone was a well recognized solvent for nitro-cellulose prior to the date of Griffiths' invention and that the effects of castor oil and resinous bodies or gums in nitrocellulose plastic compositions were well known and well recognized prior to the effective date of Griffiths' invention.

14.

The court erred in failing to hold that claim 13 of the Griffiths patent No. 1,838,618 is invalid as lacking invention over the disclosures of the prior art, particularly those patents as listed in foregoing assignment numbered 9.

15.

The court erred in failing to hold claim 16 invalid for lack of invention over the disclosures in the United States Letters Patent to Pierson No. 65,267 and the British patent to Oblasser et al. No. 19242 of 1892,

particularly in view of the fact that acetone was a well recognized solvent for nitrocellulose prior to the date of Griffiths' invention and that the effects of castor oil and resinous bodies or gums in nitrocellulose plastic compositions were well known and well recognized prior to the effective date of Griffiths' invention.

16.

The Court erred in failing to hold that claim 16 of the Griffiths patent No. 1,838,618 is invalid as lacking invention over the disclosures of the prior art, particularly those patents as listed in the foregoing assignment numbered 9.

19.

The court erred in failing to hold claim 17 of Griffiths patent No. 1,838,618 invalid in view of the state of the art, particularly those patents as listed in the foregoing assignment numbered 9.

As above pointed out, Pierson and Oblasser both disclose moldable compositions having nitrocellulose, volatile solvent, and finely divided cellulose filler. Pierson, in addition, suggests the use of oil and Oblasser suggests the use of resin and that acetone be used as a solvent.

If Griffiths did anything, he merely made a specific selection of the preferred proportion in the wider range of Pierson. *Bethlehem Steel Co. vs. Churchward International Steel Co.*, 268 F. 361 (C. C. A. 3):

“But novelty of proportions in the sense of the patent law involves something more than figuring out proportions differing from any that were known before. It involves new results from new proportions, developing a new metal, or, it may be, an old metal with new characteristics of structure or performance, embracing entirely new, or at least substantially enhanced, qualities of utility. *Glue Co. vs. Upton*, 97 U. S., 324 L. Ed. 985; *Welling vs. Crane* (C. C.) 21 F. 707; *Brady Brass Co. vs. Ajax*, 160 F. 84, 90, 87 C. C. A. 240; *Pittsburgh Iron & Steel Co. vs. Seaman-Sleeth Co.*, 248 F. 705, 160 C. C. A. 605; *Miami Copper Co. vs. Mineral Separation Ltd.*, 244 F. 752, 157 C. C. A. 200.”

In *David Belais, Inc. vs. Goldsmith Bros. Smelting & Refining Co.*, 6 F. (2d) 930, affirmed 10 F. (2d) 673 (C. C. A. 2), certiorari denied 271 U. S. 687, the court said:

“I am of the opinion that the Belais formula is the result of a mere selection of proportions to give a desired character, whiteness at the expense of ductility, and that such selection is in accord with the normal development of the art in making white gold. I do not believe that the Belais formula, even if better than others which preceded it, is an invention. The development of an old idea, and changing merely the degree, certainly does not involve invention. Novelty in proportions involves something more than merely figuring out differing proportions that were well known before. A new metal must be developed, in the sense that new results come from the new proportions, and substantially better results so far as utility is concerned must be present.

“In the present instance, the difference in degree as to the various products having slightly different proportions of the baser metals brings forth differences of opinion both as to appearance and workability. There is no startling change or narrow line of demarcation between one product and another. On the one hand, there is no absolutely bad product; and, on the other hand, there is no absolutely good product. The case of Brady Brass Co. vs. Ajax Metal Co., 160 F. 84, 87 C. C. A. 240, seems to me to be quite a point, and a quotation therefrom (page 90) seems pertinent to the instant case:

‘A mere difference in the proportions of the constituents of an alloy, however useful the result may be, does not entitle the originator to the monopoly of a patent, in the absence of other circumstances than those here disclosed.’ ”

See also, *Smith vs. Nichols*, 88 U. S. 112, 22 L. Ed. 566:

“But a mere carrying forward or new or more extended application of the original thought, ‘a change only in form, *proportions*, or degree, the *substitution of equivalents*, doing substantially the same thing in the same way by substantially the same means with better results is not such invention as will sustain a patent.” (Italics ours.)

See also,

Economy Fuse & Mfg. Co. vs. Coe, Commissioner of Patents, 86 F. (2d) 850; 31 U. S. P. Q. 193;

Minnesota Mining & Mfg. Co. vs. Coe, Commissioner of Patents, Appellate D. C.; 38 U. S. P. Q. 213;
35 U. S. C. A., section 31, note 61.

There is nothing peculiar about Griffiths' proportions nor is there anything critical about having the proportions such that the composition would be "doughy" or "putty-like." The plaintiff has represented to the trade that the Griffiths patent covers any and all wood base putties containing nitrocellulose, solvent, and wood flour or their equivalents is an infringement of this patent (Ex. Bk., p. 51). Even Griffiths' laboratory notes indicate that he did not undertake to limit his alleged invention or discovery to a doughy or putty-like composition. At Ex. Bk., p. 36, two formulas are given entitled "*Liquid Wood.*" In Exhibit 5 of the Griffiths deposition (Ex. Bk., p. 41) there are two formulas given entitled "*Concentrated Plastic Wood.*" In Exhibit 1, (Ex. Bk., p. 29) there is a further formula entitled "*Liquid Wood.*" In the formula at the upper right-hand corner of page 29, Ex. Bk., there is a formula for liquid wood containing only 12.5% wood meal comparing favorably with Pierson's minimum of one part filler, or 10%. At page 41, Ex. Bk., the lower most concentrated plastic wood formula provides for 40% wood meal, comparing favorably with the upper limit of Pierson, namely sixteen parts or 64%.

Not only are the Pierson and Oblasser disclosures direct anticipations but the entire prior art is so well

developed as to leave no room for anything such as is disclosed in the Griffiths patent to be characterized as arising to the dignity of invention.

Thus, the Merrick patent, Exhibit A-8, (Ex. Bk., p. 74) discloses a moldable composition for shoe bottoms comprising a solution of pyroxylin (nitrocellulose) with ground cork or asbestos fiber, (ll. 50 to 59.) He also says:

“finely divided wood, leather, paper-pulp, etc.”

may be substituted for the cork (ll. 59-60). In the case of substitution of finely divided wood, the same composition as Griffiths is obtained. Nor would there be anything inventive in adding castor oil to his composition. Plaintiff's expert Esselen in making up a sample of what was disclosed in Merrick, fairly loaded it with 18 grams of castor oil (R. 318) although there is nothing said about castor oil in the patent (R. 321, 322). The justification for this was merely that the patent specified that it merely was flexible. This demonstrates how well the function of castor oil in a composition of this character was known.

Thompson, Ex. A-11 (Ex. Bk., p. 87) discloses a coating made of celluloid dissolved in acetone and mixed with various substances including “vegetable, mineral or animal powders” (ll. 6 to 12). The celluloid dissolved in acetone and mixed with vegetable powder is to be used as a “*coating*” (line 7) which is the same purpose as stated in the Griffiths patent (Ex. Bk., p. 1, l. 4).

In the Black patent, Ex. A-12 (Ex. Bk., p. 91) celluloid (nitrocellulose) is dissolved in acetone and mixed with powdered silica instead of wood flour as in Griffiths (Ex. Bk., p. 91, ll. 51-59). Even Griffiths contemplated mixing his nitrocellulose compound with carborundum, see Ex. Bk., p. 42, where he has a formula for plastic carborundum. The Black patent clearly recognizes that the addition of gum to a nitrocellulose solution will impart or increase its adhesiveness (Ex. Bk., p. 91, ll. 107-111).

The Eckstein patent, Ex. A-13 (Ex. Bk., p. 95) discloses the use of both gum and castor oil in a solution of collodion (nitrocellulose), (ll. 60 to 68). As a filler, instead of using wood flour as in Griffiths he suggests the use of zinc white or heavy spar (Ex. Bk., p. 96, l. 40). Even Griffiths contemplated the use of plaster of paris and kaolin in the formulas for "Filler" and "Plastic Wood for Extrusion" (Ex. Bk., p. 42).

Hyatt and Blake, Ex. A-20 (Ex. Bk., p. 115) mixes a solution of collodion with ivory dust as a filler and molds the resulting composition. During the molding, pressure is maintained and evaporation of the solvent is accelerated by the application of heat (middle of first column, Ex. Bk., p. 115). Hyatt and Blake thus use one form of animal powder. Griffiths contemplated another form as his laboratory notes disclose the use of leather chips to make plastic leather (Ex. Bk., p. 43).

Bulling, Ex. A-26 (Ex. Bk., p. 130) mixes a solution of celluloid with calcium chloride, lines 27 to 36.

Parkes, Ex. A-28, mixes with a solution of pyroxylin (nitrocellulose) various cellulosic substances such as ground cotton fiber, (Ex. Bk., p. 139, ll. 22 to 31), and moulds billiard balls therefrom (Ex. Bk., p. 140, l. 24).

Reference to merely the above should suffice to show that it has been customary in the prior art of plastic compositions to mix a solution of nitrocellulose with a powdered or finely divided filler. The nature of the resulting product desired determines what filler to use. If a white article is desired, zinc white or ivory dust should be employed as in the Eckstein patent, Ex. A-13, and the Hyatt and Blake patent, Ex. A-20, respectively. If a black article is desired, use charcoal powder or plumbago as suggested by Pierson. If a stone-like article is desired, powdered silica should be used as in the Black patent, Ex. A-12, or, as suggested by Griffiths in his laboratory notes (Ex. Bk., p. 42), use carborundum. If a wood-like article is desired, use wood powder or sawdust as in Pierson and Oblasser. If a metallic appearing article is desired metallic powders could be employed as suggested in many of the above patents.

The prior art had developed all this. Any chemist would know from the prior art that to make a plastic composition to harden to resemble wood, all that was necessary was to mix a solution of nitrocellulose with wood powder and if you wished to make the composition less brittle, add a little castor oil and if you wanted to increase the adhesiveness of the composition, add a little gum or resin.

Plaintiff's expert Esselen testified (R. 144):

“Q. Do you believe that it would be obvious to anyone that was familiar with nitro-cellulose plastic compositions that if you wished to increase the flexibility and resilliency of the dried mass and to increase the adhesiveness that all they would have to do would be to add some castor oil and ester gum?

“A. Yes.

“Q. You believe that was true as of 1918?

“A. Yes.”

All that Griffiths did was to take a nitro-cellulose solution and mix it with finely divided wood which was taught by the prior art, and then to add a small amount of castor oil and ester gum. This was also taught by the prior art.

It cannot be urged too strongly that the Pierson and Oblasser patents were overlooked by the Patent Office and that they were not placed in evidence before the Supreme Court of the District of Columbia. The presumption of validity of the patent under these circumstances is greatly weakened, if not entirely destroyed. *Mettler vs. Peabody Engineering Corp.*, 77 F. (2d) 56 (C. C. A. 9):

“The presumption of validity which attends the issuance of letters patent is overcome in this case by the clear evidence of anticipation in the prior art which was not cited or considered by the Patent Office when the application for appellant’s patent was passed on.”

In the same case, this court said:

“As we said in the recent case of *Eagle et al. vs. P. & C. Hand Forged Tool Co.*, #7435 filed January 14, 1935,

‘It is not necessary that all of the elements of the claim be found in one prior patent. If they are all found in different prior patents and no new functional relationship arises from the combination, the claim cannot be sustained. *Keene vs. New Idea Spreader Co.*, 231 Fed. 701; see also *Keszthelyi vs. Doheny Stone Drill Co.*, 59 Fed. (2d) 3.

‘All of the elements of the patent in suit were present in the prior art and combining these elements to make the patented device did not involve invention. Widespread use of the device combining these elements old in the art is evidence of its utility but is not conclusive of its patentable novelty. *Adams vs. Belaire Stamping Co.*, 141 U. S. 539, 542; *McGhee vs. Le Sage & Co., Inc.*, 32 Fed. (2d) 875. Appellant’s patent was anticipated in the prior art and is therefore invalid.’ ”

The mere fact that Pierson did not specify acetone as his solvent or that the oil should be castor oil, or that there should be gum added, is immaterial. The use of these substances in the composition merely brings about their expected functions as taught by the prior art. The foregoing was vigorously urged upon the District Court and strenuously pressed in defendant’s Petition for Rehearing. The lower court being thus pressed to find no invention in the Griffiths patent sought escape in the following manner:

“For one thing, the claims and specifications of the Pierson patent do not disclose the ‘doughy, putty-like’ or ‘dough-like and putty-like’ characteristics of the composition of the claims of the Griffiths patent.” (R. 64.)

But the Griffiths composition is for “molding,” (Ex. Bk., p. 1, l. 5); so were Pierson’s and Oblasser’s compositions. Griffiths’ composition was for “coating” (Ex. Bk., p. 1, l. 4); so was Thompson’s composition, Ex. A. 11. The lower court thus manifestly relies upon a distinction without a difference to uphold the Griffiths claims. The situation is similar to that in *Zenitherm Co. vs. Art Marble Co.*, 56 Fed. (2d) 39 (C.C.A.5), approved in *Green Process Metal Co. v. Washington Iron Works*, 84 Fed. (2d) 892 (C.C.A.9):

“The record abundantly shows that if wood flour or other ‘finely ground vegetable matter’ as named in this claim be covered with a liquid binder, the result is a putty which is not compressible and will not be altered by pressure. This claim directly covers many of the products of the prior art and is thus anticipated by them. *American Fruit Growers, Inc., vs. Brogdex Co.*, 283 U. S., page 1. We therefore hold claims 1 and 4 to be void for want of disclosure and for too great breadth—*too much claim in the claims* and too little specification in the specifications.” (Italics ours.)

THERE IS NO INFRINGEMENT OF THE GRIFFITHS CLAIMS

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The Court erred in holding that claims 5, 8, 13, 16 and 17 of Griffiths patent No. 1,838,618 have been infringed by either the defendant or intervener.

The defendant's composition only contains 11.5% wood filler whereas Griffiths' composition, as described in his specification, contains from 15 to 30% filler with the filler content being preferably between 20 and 25% (Ex. Bk., p. 1, ll. 57-68). Claims 6, 11, 13, and 18 of Griffiths specify that the filler content shall not be lower than 15% and were accordingly held not to be infringed.

The District Court said in denying the defendant's Petition for Rehearing:

“Clearly, while the Pierson patent may narrow the scope of certain of the claims of the Griffiths patent, it does not anticipate the claims upheld by this Court.” (R. 64.)

But there is no consistency between this position and the position taken by the District Court in its original opinion. In that opinion, claims 6, 11, 15, and 18 were held not infringed (R. 61) because they were limited to the filler content as being not less than fifteen parts or that the filler content was between 15 and 30 parts. Claims 5, 8, 13, 16, and 17 do not contain these limitations. They purport to be broader—to cover “any wood base putty containing a nitrocellulose,

solvent, and wood flour, or their equivalents” (Ex. Bk., p. 51). Apparently they purport to cover a composition wherein the filler is present in less than 15 parts or only 12.5% as in the Liquid Wood composition (Ex. Bk., p. 29) or where the filler content is as high as 40% as in the Concentrated Plastic Wood 1960 (Ex. Bk., p. 41). The result as stated in the Zenitherm case, quoted supra, is that these claims directly cover

“many of the products of the prior art and is (are) thus anticipated by them.”

Claims 5, 8, 13, 16 and 17 are thus anticipated by Pierson and Oblasser. But if they are narrowed by Pierson, as stated by the District Court, then these claims, if valid at all, must be construed in the light of the specification to cover nothing more than what is covered by claims 6, 11, 15, and 18 which were held not to be infringed. If any significance can be attached to the words “doughy” and “putty-like” as was done by the District Court (R. 64) then when are the Pierson and Oblasser compositions, which are for the purpose of molding, “doughy and putty-like” and when are they not? Where is the dividing line between Pierson’s composition and Griffiths’ composition as claimed by claims 5, 8, 13, 16, and 17? If these claims are narrowed by the Pierson patent, they are not infringed, any more so than claims 6, 11, 15, and 18. If any broader, they would be infringed by Pierson’s composition and are likewise anticipated by it.

CONCLUSION

We urge this Court to correct a grievous error committed by the District Court. The District Court has undertaken to uphold claims which are of such vague, indefinite, and functional character as to fail to comply with Sec. 4888 of the Revised Statutes. It is impossible to determine from these claims when a composition is an infringement and when it is not. It is impossible to distinguish these claims, particularly claims 5 and 17, from the disclosures of Pierson and Oblasser. Claims 8, 13, and 16 contain references to castor oil, acetone, and gum, but their use and their functions were taught by the prior art. There is nothing in the alleged Griffiths invention that amounts to an invention over what was fairly taught long ago. The Patent Office denied these claims and even criticised their form as failing to comply with the requirements of R.S. 4888 (Ex. Bk., p. 60).

The Lower Court here in upholding the claims, has been erroneously influenced by the decision of the Judge who granted the patent in ignorance of the requirements of Sec. 4888 R.S., and in ignorance of the Pierson and Oblasser patents.

He has also been unduly influenced by the plaintiff's commercial success which has been largely due to the trade-name and to the enormous amounts of money that the plaintiff has been able to spend on advertising. The record shows, however, that when advertising expenses decreased, the volume of plaintiff's sales de-

creased in direct proportion. The plaintiff has merely been successful in exploiting a composition of the prior art

- (1) because it has a catchy trade-name;
- (2) because it is a successful advertiser; and
- (3) because by reason of having obtained the patent it has successfully intimidated a substantial proportion of the trade (Ex. Bk., p. 51).

These factors do not justify a patentable monopoly.

It is urged that the Lower Court be reversed.

Respectfully submitted,

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